



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

03-482

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on December 14, 2007

Signature 

Typed or printed name Karen M. Gill

Application Number

10/720,948

Filed

November 24, 2003

First Named Inventor

Paul R. Gagnon

Art Unit

3711

Examiner

Mitra Aryanpour

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.


The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 29,999

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature
Barry L. Kelmachter

Typed or printed name

203-777-6628-Ext. 112

Telephone number

December 14, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/720,948 Confirmation No. 5271
Appellant : Paul R. Gagnon
Filed : November 24, 2003
TC/A.U. : 3711
Examiner : Mitra Aryanpour

Docket No. : 03-482
Customer No. : 34704

PRE-APPEAL BRIEF REQUEST FOR REVIEW: REASONS

Sir:

This paper is submitted accompanying a Pre-Appeal Brief Request for Review.

In the office action from which appeal is taken, claims 1, 2, 7 - 10, 15, 18, and 20 - 22 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,320,094 to Arnold; claims 3 - 6, 11 - 14, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold in view of USP 4,951,658 to Morgan et al.; and claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,719,909 to Micchia et al. in view of Arnold.

Independent claim 10 is directed to a system for training an individual encouraging them to look up and forward while playing a sport without looking down at an object being controlled by the individual. The system comprises a pair of potentially disposable view restricting members, each said member being adhesively applied to one of the cheeks under an eye of said individual without covering any portion of said eye and without interfering with the individual's ability to see in upward and forward directions, and each said member having an upper edge positioned beneath said eye and a thickness sufficient to interfere with said individual's vision if said individual attempts to look down and sufficient to encourage said individual to look in said upward and forward

directions towards a field of play and at least one player on said field of play.

Independent claim 18 is directed to a method for training an individual playing a sport comprising the steps of providing at least one member having an upper edge, an adhesive coating or a layer and a thickness sufficient to interfere with said individual's field of vision and positioning said at least one member on at least one cheek under an eye of said individual in a position where said upper edge is beneath said eye and which does not cover any portion of said eye so that said thickness interferes with the individual's ability to look downwardly at a sports object being controlled by the individual and to restrict said individual's field of vision to looking forward and up towards a field of play and at least one person on said field of play.

With respect to the rejection of claims 1, 2, 7 - 10, 15, 18, and 20 - 22 as being anticipated by the Arnold patent, this reference is directed to an eye patch which completely covers the user's eye and prevents vision in any direction. The Arnold eye patch is not positioned beneath the eye. Rather, it is positioned over the eye.

Claim 1 is allowable over Arnold because Arnold does not disclose, either expressly or inherently, a piece of material positioned beneath an individual's eye "without said piece of material covering any portion of said eye so that said piece of material interferes with said individual's ability to look at said sporting object while attempting to control said sporting object due to said thickness while said piece of material allows said individual to look forward and up without any vision obstruction." An eye patch such as Arnold's obstructs all vision. Thus, an individual wearing it can not look forward and up without any vision obstruction.

Independent claim 10 is not anticipated by Arnold for the same reason and further because Arnold's eye patch does not have an upper edge positioned beneath the eye.

Independent claim 18 is not anticipated by Arnold because one using Arnold's eye patch does not perform the step of "positioning said at least one member on at least one cheek under an eye of said individual in a position where said upper edge is beneath said eye and which does not cover any portion of said eye so that said thickness interferes with the individual's ability to look downwardly at a sports object being controlled by the individual and to restrict said individual's field of vision to looking forward and up towards a field of play and at least one person on said field of play." Arnold's eye patch is positioned over the eye and its upper edge is above the eye. The eye patch covers the entire eye and one wearing it can not look forward and up towards a field of play and at least one person on said field of play.

With respect to the Examiner's contention that because Arnold's eye patch may have the same thickness as disclosed by applicant, it is reasonable to consider Arnold's eye patch as inherently being capable of performing applicant's vision-interference function recited in claims 1 and 10, Applicant submits that the Examiner has drawn the wrong conclusion. Despite its thickness, the fact remains that Arnold completely blocks the vision of the eye over which it is placed. Thus, it is incapable of performing the vision-interference function in the manner set forth in the claims. The material in Arnold is incapable of allowing a user to look forward and up without blocking the user's vision.

With respect to the argument that the positioning of the vision training device on the cheek is an intended use of the device, this argument fails to take into account that Applicant is claiming a system and the positioning of the member is essential to the operation of the system and thus should be accorded patentable

weight. Further, it is claimed that the member has an upper edge positioned beneath said eye (claim 10). This is a structural limitation not present in Arnold.

Claims 21 and 22 are not anticipated by Arnold because there is no disclosure of the piece of material being positioned so as to enable at least partial view of said sporting object at a point equal to (claim 21) or less than (claim 22) 20 degrees relative to the individual's vertical field of vision. The Examiner's argument about intended use fails because the positioning of the device is essential to the operation of the device. There is no question that Arnold's eye patch can not meet this limitation. The limitations in these claims are specifically related to the structure of the piece of material, i.e. its thickness, and its positioning relative to the eye. It is simply wrong for the Examiner to ignore these facts.

Claims 2, 7 - 9 and 15 are allowable for the same reasons as their parent claims.

With respect to the rejection of claims 3 - 6, 11 - 14, 16, and 17 on obviousness grounds, these claims are allowable for the same reasons as their parent claims. The secondary reference does not cure the deficiencies of Arnold.

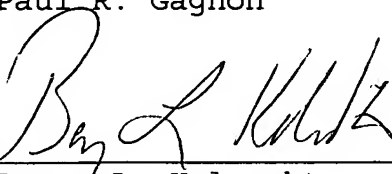
With regard to the rejection of claim 18 over the combination of Micchia in view of Arnold, the Board of Appeals has determined that Micchia does not teach or suggest the sufficient thickness limitation. To raise the contention that it does is to completely ignore the Board's decision which is not within the Examiner's purview. The Examiner is bound by the Board's determination on this issue. As noted above, Arnold is directed to an eye patch which completely blocks the vision of the eye over which it is placed. Thus, Arnold is incapable of teaching the claimed sufficient thickness limitation. Thus, even if one of ordinary skill in the art were to combine the references in the manner suggested by the Examiner, they still would not arrive at the subject matter of claim

18. The rejection also fails because the Examiner has not pointed out where the references teach or suggests the *method steps* set forth in claim 18.

Re-examination and favorable reconsideration are requested.

Respectfully submitted,

Paul R. Gagnon

By 
Barry L. Kelmachter
BACHMAN & LaPOINTE, P.C.
Reg. No. 29,999
Attorney for Applicant

Telephone: (203)777-6628 ext. 112

Telefax: (203)865-0297

Email: docket@bachlap.com

Dated: December 14, 2007